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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,828	08/31/1998	ANDERS BERKENSTAM	10806-65	4054
26161	7590	12/17/2003		
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			EXAMINER PAK, MICHAEL D	
			ART UNIT	PAPER NUMBER
			1646	
DATE MAILED: 12/17/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/143,828

Applicant(s)

BERKENSTAM ET AL.

Examiner

Michael Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 8, 9, 13-17, 51-58 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 59 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 9, 13-17, 51-58, 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 23 May 2003 has been entered.

Response to Amendment

2. The amendment filed 8 January 2003 has been entered. Claims 1-2, 8-9, 13-17, 51-58, and 60 are examined.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Applicant's arguments filed 8 January 2003, have been fully considered but they are not found persuasive.
5. Newly submitted claims 59 and 61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
- Claims 59 and 61 are drawn to group II.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59 and 61 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

6. Claims 1-2, 8-9, 13-17, 51-58, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Kausch et al.(A).

The reason for the rejection has been set forth previously.

Kausch et al. disclose the isolation of chromosome (column 5). The cell source are human cells (column 6, lines 5-15). Many chromosomes can be sorted at once (column 9, lines 29-43). Large amounts of pure chromosomes and DNA of the chromosomes is isolated (column 10, lines 22-25). Cells transfected with chromosomal DNA is disclosed (column 10, lines 22-25).

Claims encompass chromosomal DNA because the claims encompass polynucleotide sequence comprising the polynucleotide sequence encoding a polypeptide with SEQ ID NO:2 including the genomic DNA of SEQ ID NO:3. The isolated and purified chromosomes comprise the polynucleotide sequence encoding a polypeptide with SEQ ID NO:2. Chromosomal DNA inherently are operably linked to an expression control sequences. Chromosomal DNA inherently comprises heterologous sequence because it undergoes recombination.

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Applicants argue that Kausch disclosure of human and mouse chromosomal DNA do not constitute disclosure of an isolated nucleic acid encoding the human polypeptide sequence of SEQ ID NO:2 or a fragment thereof containing the DBD and/or LBD. However, as discussed above the chromosomal DNA comprises the claimed nucleic acid especially the genomic DNA encompassing claims. The newly amended claims are still generic and encompasses the DNA of Kausch.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Michael Pak.

Primary Patent Examiner

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10 December 2003